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EXAMINER	
CHUNG, JASON J	
ART UNIT	**PAPER NUMBER**
2611	25

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/476,291	RANTA, CRAIG S.	
	Examiner	Art Unit	
	Jason J. Chung	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25,27-29 and 31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25,27-29 and 31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/15/04 have been fully considered but they are not persuasive. The applicant argues on pages 10, line 7-page 12, line 17 of the arguments and specifically on page 10, lines 19-21 that filtering based on a preference profile will likely lead to coupons not wanted. The examiner respectfully disagrees with this assertion. The claim recites "automatically analyzing the extracted coupon data produced by the decoder, such that only coupons defined by the extracted coupon data that correspond to the at least one of the different products and services selected by the user in setup mode are automatically stored in the non-volatile memory...discarded". Williams discloses the user generates a preference profile (column 6, lines 5-12). Williams discloses the user indicates desires of products and services to generate a preference profile (column 6, lines 13-33). Williams discloses the system filters coupons based on the preference profile compiled and stored in the client and coupons that satisfy (only coupons defined that correspond) the preference profile are passed to the client device (column 6, lines 49-56), which meets the limitation on automatically analyzing...discarded.

Williams discloses the coupons delivered to the user may be for products, activities, or services enjoyed by the user (column 6, lines 25-28), which meets the limitation on products and services. Williams discloses the user may disclose various preferences as part of some other promotion and the preference data is compiled and maintained on a client (column 6, lines 2-12); the user setting up their preferences reads on setup mode, which meets the limitation on a plurality of control keys configured to selectively respond to actuation by a user and enabling a

user to selectively manipulate at least one of the plurality of control keys to select a setup mode prior to transmission session, the controller responding to the selection of the setup mode by causing a menu including a plurality of different products and services to be presented to the user on the display. Williams discloses the preference profile allows the user to receive coupons that have a preference related to the user's preference (column 6, lines 25-28). Williams discloses the preference profile compiled by and stored in the client filters the incoming coupons (column 6, lines 49-56).

Applicant's arguments with respect to page 12, line 18-page 13, line 25 of the arguments have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues on page 13, line 26-page 15, line 6 of the arguments that Williams disclosing a preference profile is different from receiving a coupon related to a specific product or service. The examiner respectfully disagrees with this assertion. The independent claims states "automatically analyzing the extracted coupon data produced by the decoder, such that only coupons defined by the extracted coupon data that correspond to the at least one of the different products and services selected by the user in setup mode are automatically stored in the non-volatile memory...discarded". Williams discloses indicating products and services (column 6, lines 13-33). Williams discloses the preference profile is stored in the client and coupons that satisfy the preference profile are passed to the client device (column 6, lines 49-56), which meets the limitation on coupons corresponding to the preference profile are stored.

The applicant argues on page 15, lines 7-27 of the arguments that the claims now state sufficiently portable to be transportable and therefore is not met by Mankovitz. The examiner respectfully disagrees with this assertion. Mankovitz discloses the controller can be connected to

the electronic coupon via a hard wire 18, 20 or IR emitter (column 3, lines 44-62 and column 6, lines 53-58). Mankovitz discloses the decoder 50 is part of the controller (column 6, lines 30-39). Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a); the system is capable of being moved from one area to another and therefore meets the limitation on the elements being encompassed in a common housing, the common housing being sufficiently portable that the electronic coupon is transportable to a retailer so that coupons stored thereon can be redeemed.

Applicant's arguments with respect to page 15, line 28-page 16, line 22 of the arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to page 16, lines 23-30 of the arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-25, 27, 29, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz (US Patent # 5,523,794) in view of Small (US Patent # 5,808,689) in further view of Terrill (US Patent # 6,052,755) in further view of Levitan (US Patent # 5,534,911) in further view of Williams (US Patent # 6,075,971).

Regarding claim 1, Mankovitz discloses electronic coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 6, lines 30-39), which meets the limitation on a decoder configured to receive a video signal during transmission session and to extract coupon data from the video signal producing extracted coupon data.

Mankovitz discloses a portable data coupon 10 receives coupon information from the VBI (column 3, lines 44-62), which meets the limitation on an electronic coupon. Mankovitz discloses the portable coupon data has a display 22 and a save key 28 (column 3, line 63-column 4, line 7), which meets the limitation on the coupon configured to selectively store and selectively display coupons defined by the extracted coupon data.

Mankovitz discloses electronic coupon information is displayed (column 5, lines 46-56), which meets the limitation on a displayed that displays coupons defined by the extracted coupon data.

Mankovitz discloses a microprocessor 35 (controller) (figure 2) that is coupled to RAM (storage) 36 and a liquid crystal display (column 4, lines 13-28), which meets the limitation on a controller configured to process the extracted coupon data produced by the decoder, controller being coupled to the storage and a display.

As previously disclosed, Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Mankovitz fails to disclose the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum problems (column 5, lines 24-55). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

As previously disclosed, Mankovitz discloses the coupons are stored in a RAM (volatile memory) (column 4, lines 12-18 and column 4, lines 35-53). Neither Mankovitz nor Small discloses a non-volatile memory. Terrill discloses a RAM, non-volatile memory, magnetic **and/or** optical media and the like are interchangeable (column 9, lines 8-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small to have a non volatile memory or any other type of memory instead of a RAM as taught by Terrill in order to give more system versatility.

Neither Mankovitz, Small, nor Terrill discloses the plurality of control keys used to bring up a menu of user desires. Levitan discloses a user uses a remote control 38 to bring up the personal channel and the user rearranges the channels in the personal channel (column 3, lines 36-59; figure 4), which meets the limitation on a plurality of control keys used to bring up a menu of user desires. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small in further view of Terrill to have a plurality of control keys bring up a menu so the user can select their desires as taught by Levitan in order to enable the user to have an active part of what content they are presented.

Mankovitz, Small, Terrill, and Levitan are silent as to the products or services. Neither Mankovitz, Small, Terrill, nor Levitan discloses enabling...on the display, enabling...in the electronic coupon, and automatically analyzing. Williams discloses the coupons delivered to the user may be for products, activities, or services enjoyed by the user (column 6, lines 25-28), which meets the limitation on products and services. Williams discloses the user may disclose

various preferences as part of some other promotion and the preference data is compiled and maintained on a client (column 6, lines 2-12); the user setting up their preferences reads on setup mode, which meets the limitation on a plurality of control keys configured to selectively respond to actuation by a user and enabling a user to selectively manipulate at least one of the plurality of control keys to select a setup mode prior to transmission session, the controller responding to the selection of the setup mode by causing a menu including a plurality of different products and services to be presented to the user on the display.

Williams discloses the preference profiles allows the user to receive coupons that have a preference related to the user's preference (column 6, lines 25-28), which meets the limitation on enabling a user to manipulate at least one of the plurality of control keys to select at least one of the different products and services displayed in the menu, selection of a product or a service indicating that the user desires extracted coupon data corresponding to the product or a service indicating that the user desires extracted coupon data corresponding to the product or the service selected to be stored in the electronic coupon.

Williams discloses the preference profiles allow the user to receive coupons that have a preference related to the user's preference (column 6, lines 25-28). Williams discloses the preference profile compiled by and stored in the client filters the incoming coupons (column 6, lines 49-56), which meets the limitation on automatically analyzing the extracted coupon data produced by the decoder, such that only coupons defined by the extracted coupon data that correspond to the at least one of the different products and services selected by the user in the setup mode are automatically stored in the memory, and each coupon defined by the extracted coupon data that does not correspond to the at least one of the different products and services

selected by the user in the setup mode is automatically discarded. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small in further view of Terrill in further view of Levitan to have the products and services selected by the user using control keys as taught by Williams in order to give the user the decision making power over the type of coupons they want to be received.

Regarding claim 2, Mankovitz discloses the controller can be connected to the electronic coupon via a hard wire 18, 20 or IR emitter (column 3, lines 44-62 and column 6, lines 53-58). Mankovitz discloses the decoder 50 is part of the controller (column 6, lines 30-39). Mankovitz discloses the controller 12 (decoder) can have a moiety connector 18 and receive a second moiety connector 20 of the coupon (column 3, lines 44-62; figure 1a); the system is capable of being moved from one area to another and therefore meets the limitation on the elements being encompassed in a common housing, the common housing being sufficiently portable that the electronic coupon is transportable to a retailer so that coupons stored thereon can be redeemed.

Regarding claim 3, Mankovitz discloses the portable data coupon includes a display (column 3, lines 63-65). Mankovitz discloses the display is a LCD (column 4, lines 18-27).

Regarding claims 4-5, Mankovitz discloses the coupon is displayed as an UPC code (column 8, lines 10-23). Mankovitz discloses the coupon is called up in an UPC code and it is scanned at a cash register (column 8, lines 23-41), which meets the limitation on the UPC being read by a bar code scanner.

Regarding claim 6, as disclosed in claim 1 rejection, Williams, Mankovitz, and Small discloses television broadcast.

Regarding claim 7, Mankovitz discloses the television broadcast comprises commercials (column 5, lines 26-35).

Regarding claim 8, neither Mankovitz, Small, Terrill, Levitan, nor Williams discloses a full memory deleting coupons in order to store additional coupons. The examiner takes Official Notice that memory purging of full memories is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz in view of Small in further view of Terrill in further view of Williams to have memory purging of full memories in order to preserve system resources.

Regarding claims 9-10, Williams discloses the coupons that correspond to the profile are stored (column 6, lines 25-33), which meets the limitation on when in a storage mode, the controller analyzes the data and saves each coupon corresponding to the products and services selected by the user in the setup mode. Williams discloses the coupons are redeemed by the user (column 6, lines 49-56), which meets the limitation on when in redeem mode, the controller causes each coupon stored in the electronic coupon to be presented to the user. Williams discloses the user generates a preference profile (column 6, lines 5-7), which meets the limitation on setup mode. Levitan discloses the final list of user desires is displayed after the user indicates their desires (column 3, lines 36-59), which meets the limitation on presenting on a menu the user results.

Neither Mankovitz, Small, Terrill, Levitan, nor Williams discloses an extra button (mode key) being able to select between the setup mode, storage mode, and redeem mode. The examiner takes Official Notice that a button presenting a list of options to the user is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify Mankovitz in view of Small in further view of Terrill in further view of Levitan in further view of Williams to have an extra button presenting a list of options to the user in order to present the list only when the user wants to see the list.

Regarding claims 11-12, Terrill discloses a RAM, ROM (electrical circuit), magnetic **and/or** optical media and the like are interchangeable (column 9, lines 8-10).

Regarding claims 13, 14, the limitations in claims 13, 14 have been met in claims 1, 6 rejection

Regarding claim 15, Mankovitz discloses the decoder used in a VCR to perform the functions (column 6, lines 18-28), which meets the limitation on transmission comprises a playback of a video taped program.

Regarding claims 16-19, the limitations in claims 16-19 have been met in claims 9-10 rejections.

Regarding claims 20-21, the limitations in claims 20-21 have been met in claims 4-5 rejections.

Regarding claims 22-23, the limitations in claims 22-23 have been met in claims 11-12 rejections.

Regarding claim 24, 27, 29, 31 the limitations in claims 24, 27, 29, 31 have been met in claims 1, 2, 9 rejections.

Regarding claim 25, the limitations in claim 25 have been met in claim 11 rejection.

3. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Small.

Regarding claim 28, Mankovitz discloses coupon data is transmitted in the VBI of a television signal (column 5, lines 26-50). Mankovitz discloses encoded data is extracted from the VBI using a VBI decoder (column 3, lines 44-62), which meets the limitation on providing an electronic coupon including a decoder configured to extract coupon data from the video signal, receiving the video signal at the electronic coupon during a transmission session, and on extracting coupon data from the video signal using the decoder in the electronic coupon. Mankovitz discloses the portable coupon data 10 can join the controller 12 (figure 1) with connectors 18, 20 or with a wireless interface (column 3, lines 44-62), which meets the limitation on the components of the electronic coupon are encompassed in a common housing. Mankovitz discloses the electronic coupon data is displayed with the redemption system (column 5, lines 46-56; figure 1b). Mankovitz discloses the electronic coupon is displayed and redeemed at the cash register (column 8, lines 24-41), which meets the limitation on readily taken to a retailer to redeem a coupon stored in the electronic coupon.

Mankovitz discloses the read key that lets the user decide what they want to do with the data (column 3, line 63-column 4, line 7). Mankovitz discloses the read key lets the user determine, whether to save the coupon for later redemption (column 5, line 57-column 6, line 5). Mankovitz discloses the save key being pressed, the coupon data is saved for later redemption (column 5, line 57-column 6, line 5), which meets the limitation on storing the coupon data extracted by the decoder in the electronic coupon.

Mankovitz discloses the electronic coupon is displayed and redeemed at the cash register (column 8, lines 24-41); the system (decoder and coupon joined) is capable of being moved from one area to another and therefore meets the limitation on taking the electronic coupon that

includes the decoder to a retailer, to redeem a coupon stored in the electronic coupon and displaying the electronic coupon to a retailer to redeem the electronic coupon.

As previously disclosed, Mankovitz discloses the coupon data is transmitted in the VBI of a television signal. Mankovitz fails to disclose the coupon data in the horizontal overscan. Small discloses transmitting data in the horizontal overscan portion of a television signal to avoid interfering with the blanking intervals in order to avoid 60-cycle hum (column 3, lines 44-57 and column 5, lines 24-36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mankovitz to have the data in the horizontal overscan instead of the VBI as taught by Small in order to avoid interfering with the closed captioning signal.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC

CHRIS GRANT
PRIMARY EXAMINER